

wherein the olefin copolymer has a glass transition temperature  $T_g$  of lower than 60°C.--

#### REMARKS

Claims 3 and 5-13 are active in the present application. Independent Claim 10 has been amended to limit the copolymer to containing from 0.1 to 4 mol% of polymerized units of a cyclic olefin. Support for the amendment is found in Example 3 on page 66 where the cyclic olefin norbornene is present in an amount of 4 mol%. No new matter is added.

#### REQUEST FOR RECONSIDERATION

Applicants thank Examiner Asinovsky for the helpful and courteous discussion of April 9, 2003. During the discussion the Examiner agreed that further limiting the claimed copolymer by restricting the amount of cyclic olefin to 0.1 to 4 mol% would bring the claims into condition for immediate allowance.

Claim 10 has been amended herein to limit the amount of cyclic olefin to from 0.1 to 4 mol%.

The Office has asserted that the claimed composition is obvious in view of compositions described in Farley (U.S. 5,874,512). Farley discloses at column 17, lines 1-9:

For use as a tackifier, resins produced herein preferably have about 5 mole percent or more incorporation of cyclic olefins, more preferably in the range of from about 10 mole percent to about 90 mole percent, even more preferably in the range of from about 5 mole percent to about 85 mole percent, even more preferably from about 10 mole percent to about 80 mole percent, even more preferably from about 15 mole percent to about 75 mole percent, most preferably from greater than 20 mole percent to 75 mole percent.

Farley does not disclose a copolymer wherein the cyclic olefin must be present in amounts of from 0.1 to 4 mol% (see for example Tables 2-4). The presently claimed invention, wherein the cyclic olefin must be present in amounts not greater than 4 mol%,

cannot be obvious in view of the Farley compositions which are disclosed to "have about 5 mole percent or more" of the cyclic olefin present.

Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §103(a).

During the discussion, Applicant's U.S. representative brought to the Examiner's attention that the compositions of the Farley reference are disclosed as useful for tackifiers and adhesives. The claimed composition is useful for, *inter alia*, preparing films and sheets that are used as substitutes for polyvinylchloride films. Polyolefin films are often used in applications such as Saran™ wrap which is in widespread use in consumer applications. Environmental concerns have encouraged film producers to move towards non-chlorine containing films (page 1, lines 13-16). Such films can be formed by molding the claimed copolymer alone or as mixtures with other polymers (e.g., blow molding, casting, extrusion, calendaring, etc., page 57, lines 2-20).

Blends of the prior art composition are described as useful as adhesives on substrates (column 20, lines 36-39). Although it is disclosed that the adhesives can be applied as a coating or film onto a backing material (column 20, lines 53-55) there is no disclosure that the prior art compositions can be used as a molded films or molded sheets. In the Tables of the Farley patent (see Table 2), the adhesive performance of various compositions which contain the prior art composition are demonstrated. In none of these Examples is the composition a molded film or sheet. Rather the prior art compositions are cast onto Mylar to provide a dry layer of the formulated adhesive (column 28, lines 60-67).<sup>1</sup>

Dependent Claim 8 is drawn to films or sheets that comprise the composition of the invention. Such molded films or sheets are nowhere described or disclosed in the prior art

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<sup>1</sup> At column 19, lines 64-67 it is noted that the components of the pressure sensitive adhesives can be blended by methods that include extruder blending, however no mention is made that a film may be extruded or molded.

relied upon by the Examiner. Applicants submit that the films and/or sheets of dependent Claim 8 cannot be obvious in view of a tackifying or adhesive composition that is nowhere described as a self standing film or sheet.

Applicants submit the amendment to the claims places all now-pending claims in condition for allowance. Applicants respectfully request the withdrawal of the rejections and the passage of all now-pending claims to Issue.

Respectfully submitted,

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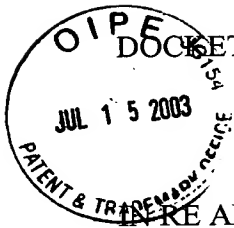
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Serial No: 09/857,191

Amendment Filed on: HERewith

--10. (Amended) An olefin copolymer comprising polymerized units of  
0.1 to [10] 4 mol% of a cyclic olefin;  
0.1 to 45 mol% of an aromatic vinyl compound; and  
an aliphatic  $\alpha$ -olefin having from 2 to 20 carbon atoms,  
wherein the cyclic olefin and the aromatic vinyl compound account for from 0.2 to  
[50] 49 mol% of the olefin copolymer; and  
wherein the olefin copolymer has a glass transition temperature  $T_g$  of lower than  
60°C.--



DOCKET NO: 205494US0X PCT

"RESPONSE UNDER 37 CFR 1.116-  
EXPEDITED PROCEDURE EXAMINING  
GROUP 1711"

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IS RE APPLICATION OF

KIYOHICO YOKOTA, ET AL.

SERIAL NO: 09/857,191

FILED: JUNE 20, 2001

FOR: OLEFIN COPOLYMERS, AND  
FILMS AND SHEETS

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: EXAMINER: ASINOVSKY, O.

:

: GROUP ART UNIT: 1711

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REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Advisory Action of June 26, 2003, Applicants respectfully request reconsideration of the above-identified application in view of the following remarks.

REMARKS

Applicants thank Examiner Asinovsky for the helpful and courteous discussion of July 8, 2003. During the discussion, Applicants' U.S. representative presented arguments that the upper limit for the cyclic olefin content in amended Claim 10 is supported by Example 3 on pages 65-66 of the specification. The Examiner appeared to agree that the amount of norbornene, a cyclic olefin, is 4 mol% in Example 3 on page 66 of the specification.

In the Advisory Action of June 26, 2003, the Office did not enter the Amendment and Request for Reconsideration filed with the Office on June 10, 2003 on the grounds that (1) "[t]he narrow limitation of the amount of a cyclic olefin from 0.1 to 4 mol% would require a

new search” and (2) “[t]he working example 3 at page 65 discloses the lower limitation of a norbornene olefin of 4.76 mol%. The limitation up to 4 mol% is a new matter.”

With regard to (2), as was mentioned above, the specification as filed discloses on page 66 in Example 3 that norbornene is present in an amount of 4 mol%. The addition of an upper limit of 4 mol% in amended Claim 10 is therefore not new matter.

In the Interview Summary of April 9, 2003, it was written “the present independent Claim 10 is a composition, the amount of a cyclic olefin could be amended to make a difference with a composition of Farley.” Applicants submit that the comments in the Interview Summary evidence that the Office acceded to entry of an after final amendment limiting the amount of cyclic olefin to 0.1 to 4 mol%. Applicants respectfully request entry and consideration of the Amendment and Request for Reconsideration filed on June 10, 2003 (copy attached for convenience).

Applicants submit that the amendment to Claim 10 to limit the amount of cyclic olefin to from 0.1 to 4 mol% is sufficient to overcome the rejection in view of the patent to Farley (U.S. 5,874,512). Nowhere in the Farley patent is it disclosed or suggested that the prior art composition contains from 0.1 to 4 mol% of a cyclic olefin. In fact, Farley discloses the following:

For use as a tackifier, resins produced herein preferably have about 5 mol% or more incorporation of cyclic olefins, more preferably in the range of from about 10 mol% to about 90 mol%, even more preferably in the range of from about 5 mol% to about 85 mol%, even more preferably from about 10 mol% to about 80 mol%, even more preferably from about 15 mol% to about 75 mol%, most preferably from greater than 20 mol% to 75 mol% (column 17, lines 1-9).

The presently claimed invention, drawn to a copolymer having a cyclic olefin present in an amount of from 0.1 to 4 mol%, is not obvious or anticipated by the Farley patent which discloses that the prior art copolymer must have at least “about 5 mol%” of cyclic olefins. By teaching that greater amounts of cyclic olefin are preferred (e.g., “most preferably from

greater than 20 mol% to 75 mol%”) the Farley patent teaches away from the presently claimed invention. The presently-claimed invention cannot be obvious in view of a reference containing such a relevant contradictory teaching.

Applicants submit that the Amendment and Request for Reconsideration filed with the Office on June 10, 2003, should be entered in view of the comments on the Interview Summary. Applicants further submit that the amendment to Claim 10 overcomes the rejections of record as evidenced by the prior art reference’s contradictory teachings towards compositions containing less than 5 mol% of a cyclic olefin.

Applicants respectfully request the entry of the Amendment and Request for Reconsideration filed with the Office on June 10, 2003, and the passage of all now-pending claims to Issue.

Respectfully submitted,

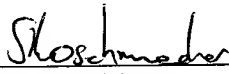
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